

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 0103085-0519322			
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>05/02/2007</u></p> <p>Signature </p> <p>Typed or printed name <u>Andrew B. Ulmer</u></p>		Application Number 10/051,555	Filed 01/17/2002		
<p>First Named Inventor Mindrum, Gordon Scott</p> <table border="1"> <tr> <td>Art Unit 2173</td> <td>Examiner Hailu, Tadesse</td> </tr> </table>				Art Unit 2173	Examiner Hailu, Tadesse
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. **57,003**
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Answers to Questions

05/02/2001

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of 2 forms are submitted

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

PATENTS

UNITED STATES PATENT AND TRADEMARK OFFICE

Application: 10/051,555

Examiner: Hailu, Tadesse

Filed: 01/17/2002

Art Unit: 2173

Inventor: Mindrum, Gordon Scott

Atty. Ref.: 0103085 - 0519322

Title: **METHOD AND APPARATUS FOR RECORDING AND PRESENTING
LIFE STORIES**

PRE-APPEAL BRIEF
(in accordance with 1296 Off. Gaz. Pat. Office 67 (July 12, 2005))

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Office Action dated 02/12/2007 contains clearly improper rejections based on clear errors in facts, and it contains the omissions of an essential element needed for the *prima facie* obviousness rejections issued in the Office Action. These errors and omissions will be addressed with respect to the only pending independent claim.

Claim 39:

Claim 39 recites, among other things, "providing a life pack to a person associated with a deceased person, wherein the life pack comprises:

- i) requests for the person associated with the deceased person to provide particular types of biographical information relating to the deceased person, and
- ii) instructions, to the person associated with the deceased person, regarding how to provide the requested particular types of biographical information relating to the deceased person in response to the requests."

In the pending Office Action, the Office conceded that the combined art of record fails to teach part "ii)" of this limitation, yet the Office completely failed to address part "i)" of this limitation.

(See p. 6 of the Office Action dated 02/12/07). The complete failure of the Office to address part “i)” of the above noted limitation in any way, by itself constitutes clear error.

In addition, because the Office could not find part “ii)” of this limitation in the prior art, the Office simply stated, in conclusory fashion, and with no evidentiary support, that it would have been obvious to incorporate the subject matter of part “ii)” into the teachings of the combined prior art. This failure to provide any evidentiary support to establish a teaching or suggestion in the prior art for a claimed limitation constitutes clear error. (See *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999), which holds that obviousness rejections must be based on actual evidence, not merely conclusory statements; see also MPEP 2145).

Furthermore, in apparently trying to address the claim language “types of biographical information,” the Office refers to media formats such as CD-ROM, Video Cassette, and print outs as described in the prior art. Applicant submits that one of ordinary skill in the art would immediately recognize that “types of biographical information” as recited in claim 39 is a completely different concept from *types of media format* as discussed in the Office Action. Indeed, in the context of claim 39, the two concepts are conceptually separate and independent from one another. For instance, where only the type of media format (e.g., CD-ROM, video cassette, etc.) is specified, any type of biographical information (e.g., date of birth, date of death, etc.) may be submitted in that specified particular format unless the required type of biographical information is also specified. Similarly, where only the type of biographical information is specified, it may be submitted in any specified particular type of media format unless the required type of media format is also specified. Again, claim 39 itself recites only biographical information types, and mentions nothing whatsoever of media format types. Accordingly, this apparent attempt by the Office to equate “types of biographical information” with *types of media* that happen to contain biographical information, in the context of claim 39, constitutes clear error.

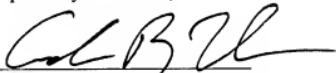
In view of the foregoing, Applicant submits that the Office Action dated 02/12/2007 contains clearly improper rejections based on several clear errors in facts, and it contains an omission of an essential element needed for the *prima facie* obviousness rejections issued in the Office Action for at least the following three independent reasons: (1) the Office completely failed to address part “i)” of the above-quoted limitation of claim 39; (2) the Office failed to provide any evidentiary support to show a teaching or suggestion to incorporate part “ii)” of the

above-quoted limitation of claim 39 into combined prior art teachings; and (3) the Office impermissibly attempted to equate “particular types of biographical information” with particular *types of media* containing any (i.e., no particular) type of biographical information. The Office’s apparent position that the combined art teaches the above-quoted limitations of claim 39 therefore constitutes clear error in facts. Furthermore, because the Office has otherwise failed to show how this limitation is taught or suggested by the combined prior art, the Office has failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.03.

Conclusion:

Applicant notes that the dependent claims add other limitations that further distinguish over the cited references, providing additional bases for patentability. In view of the foregoing, Applicant respectfully requests that the Pre-Appeal Brief Conference Panel withdraw and reverse the Examiner’s rejections of all of the claims on appeal, and that the pending claims be allowed in due course. Applicant reserves all rights and arguments with respect to those claimed features not expressly discussed above. Should this submission not comply with the submission requirements, or if the Panel has any outstanding issues to be addressed, the Applicant invites the Panel to contact the undersigned at (513) 369-4811, or at aulmer@fbtlaw.com.

Respectfully Submitted,


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